

REMARKS

Entry of the foregoing amendments, and reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. § 1.104 and § 1.112, and in light of the following remarks, are respectfully requested.

An Information Disclosure Statement is also submitted.

Amendments and Rejections under 35 U.S.C. 112

Claim 1 is amended to include the thickness of the film, as recited in original claim 16, and to specify that the material is a magnetic loss material.

Claim 7 has been amended as suggested by the Office, to depend from claim 6.

Claims 18 and 19 were rejected hereunder as including bwr values not described. As now amended, each of these claims recites the bwr as between 148% and 200%, the former value appearing in applicants' Example 1, and the latter value appearing in original claim 2.

New dependent claims 21 and 22 are supported by original claims 2 and 5.

No new matter is presented.

Rejection under 35 U.S.C. §102 over JP 09-181476

This rejection is respectfully traversed. The rejection notes certain values in JP '476 that appear to overlap those in the present claims or specification, and bases the rejection on the apparent similarity of the processes for making the compositions, hence this is a rejection based on inherency.

Applicants' Fig. 3 shows μ''_{\max} at over 1000 and Fig. 4 (example 2) shows a μ''_{\max} value of about 500. JP '476 does not show any values of μ''_{\max} reaching 500. For a μ''_{\max} of 100, Figs. 3, 6, and 7 of JP '476 reach this value at about 20MHz in all cases, whereas applicants' Figs. 3 and 4 show reaching this value at about 60MHz and 25MHz respectively. At the high end, applicants' figures show that μ''_{\max} of 100 is achieved at frequencies beyond those tested (3 GHz and 2 GHz, respectively), whereas JP '476 reaches that value at not more than 1 GHz. Thus, the claimed invention achieves good suppression or absorption

characteristics, whether narrow band (Fig. 3) or broad band (Fig. 4), much earlier and much later than disclosed in the reference. Further, these results are achieved with truly thin films, the examples show thicknesses of $\leq 2\mu\text{m}$, whereas JP '476 describes film thicknesses of 1mm (¶0042 and ¶0047; the Japanese language reference shows the same value in Arabic script). Based on at least this thickness limitation, JP '476 does not anticipate claims 1, 6-9, 12, or 19, nor render any of them obvious. Accordingly, this rejection should now be withdrawn.

Rejection under 35 U.S.C. §102 over Han et al.

This rejection is respectfully traversed. As with the rejection over JP '476, the rejection takes certain values from Han *et al.* that appear to overlap those of the claimed device, and on the basis that the processes of making the thin films are the same, alleges that the products are the same; again, an inherency argument.

While the present specification does not disclose values for μ' , both Han *et al.* and JP '476 do, although Han discloses values only up to 100 MHz. In both Han *et al.* and JP '476, μ' is essentially flat (slightly falling) up to 100 MHz. By the Office's inherency argument, Han *et al.*'s compositions then would be expected to have μ'' values akin to those shown in JP '476. Yet as shown above, the μ'' values achieved by applicants are strikingly different than shown in JP '476.

The "Introduction" portion of the Han *et al.* article discusses creating the equivalent of ferrite cores for inductors and transformers as thin films on ICs. In contrast, the present application is directed the equivalent of cores having a high loss characteristic to absorb high frequency noise (application at page one). For inductors and transformers, as in Han *et al.*, increased loss is not desired because losses will decrease the efficiency of the device, whereas for the noise suppression composition of the present invention a high loss is desirable because the suppression will be more efficient.

Accordingly, the assumption that the claimed μ''_{\max} and bwr will inherently be present in the Han *et al.* composition is not valid, and this rejection should thus be withdrawn.